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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO
10/613,156	07/03/2003	Kimio Takahashi	075834.00410	9196
7	590 09/22/2004		EXAMINER	
Robert J. Dep			RICKMAN	, HOLLY C
Holland & Kni			ART UNIT	PAPER NUMBER
30th Floor 131 South Dea	rborn Street		1773	
Chicago, IL 60603-5506			DATE MAILED: 09/22/2004	

Please find below and/or attached an Office communication concerning this application or proceeding.

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION. Eathermore of one may be windered the provision of 37 CPR 1.75(6), in no exent, however, may a righty be timely filled and the provision of the prov				\sim				
Examiner		Application No.	Applicant(s)	4				
Holly Rickman		10/613,156	TAKAHASHI, KIMIO					
The MALING DATE of this communication appears on the cover sheet with the correspondence address — Period for Reply A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ② MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION. Extension of size may be achieve under the provisors of 3 CFR 1.13(a), in no event, towever, may a reply be timely filled If the period for reply appelled above is base than thisty (30) days, an early within the statutory minimum of thirty (30) days, we the considered streety. If the period for reply appelled above is base than thisty (30) days, an early within the statutory minimum of thirty (30) days, we the considered streety. If the period for reply appelled above is base than thisty (30) days, an early within the statutory minimum of thirty (30) days, we the considered streety. If the period for reply appelled above is been about the statutory period and application to become ASHNDOHED (30 U.S.C. § 133). Any reply received by the Office later than office in contractation, each firm of the statutory and the contractation, each firm of the statutory and the contractation, each firm of the communication, each firm of the communication. Provided the statutory of the communication is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Exparte Quayle, 1935 C.D. 11, 453 O.G. 213. Disposition of Claims Alia Claim(s)	Oπice Action Summary	Examiner	Art Unit	٠.				
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1) □ Responsive to communication(s) filed on 2a) □ This action is FINAL. 2b) ☑ This action is non-final. 3) □ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213. Disposition of Claims 4) □ Claim(s) 1-4 is/are pending in the application. 4a) Of the above claim(s) is/are withdrawn from consideration. 5) □ Claim(s) 1-4 is/are rejected. 7) □ Claim(s) is/are objected to. 8) □ Claim(s) are subject to restriction and/or election requirement. Application Papers 9) □ The drawing(s) filed on 03 July 2003 is/are: a) □ accepted or b) □ objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheel(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d). 11) □ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152. Priority under 35 U.S.C. § 119 12) ☑ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). a) ☑ All b) □ Some *c) □ None of: 1. ☑ Certified copies of the priority documents have been received. 2. □ Certified copies of the priority documents have been received in Application No 3. □ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)). * See the attached detailed Office action for a list of the certified copies not received. Altachment(s) 1) ☑ Notice of References Clied (PTO-882) 2) □ Notice of Transpersson's Patent Drawing Review (PTO-948) 3) □ Notice of Dranspersson's Patent Drawing Review (PTO-948) 5) □ Notice of Informal Patent Application (PTO-152) 6) □ Other: □ Others: □ Others	THE MAILING DATE OF THIS COMMUNICATION. - Extensions of time may be available under the provisions of 37 CFR 1.1: after SIX (6) MONTHS from the mailing date of this communication. - If the period for reply specified above is less than thirty (30) days, a reply If NO period for reply is specified above, the maximum statutory period Failure to reply within the set or extended period for reply will, by statute Any reply received by the Office later than three months after the mailing	36(a). In no event, however, may a reply be ting within the statutory minimum of thirty (30) day will apply and will expire SIX (6) MONTHS from a cause the application to become ABANDONE	nely filed s will be considered timely. the mailing date of this communicatio D (35 U.S.C. § 133).	n.				
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Application/Control Number: 10/613,156

Art Unit: 1773

DETAILED ACTION

Claim Rejections - 35 USC § 103

- 1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
 - (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
- 2. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Meguro et al. (US 2002/0018914).

Meguro et al. disclose a magnetic recording tape (elongated substrate) having an underlayer and a magnetic recording layer formed thereon wherein the recording layer has a thickness as low as 10 nm (see abstract). The reference teaches that the underlayer is formed from any one of a number of inorganic materials including silicon nitride (paragraph 74). It would have been obvious to one of ordinary skill in the art to choose any one of the inorganic materials from within the disclosed group in view of the implied functional equivalence of the materials.

It is noted that the limitation "formed by a vacuum thin film forming technique" is a process limitation in an article claim. It is the Examiner's contention that the structure taught by Meguro et al. is the same as the claimed structure. Thus, in the absence of evidence that the claimed method limitation results in a materially different product, this method limitation does not patentably distinguish over Meguro et al.

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Art Unit: 1773

It has been held that even though process limitations in product claims limit and define the product by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. See *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

3. Claims 2-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishikawa et al. (US 5795642).

Ishikawa et al. disclose a magnetic recording tape (elongated substrate) having an back coating layer formed from multiple layers and a magnetic recording layer formed on the opposite side of the substrate wherein the recording layer has a thickness as low as 50 nm (see abstract). The reference teaches that the underlayer is formed from any one of a number of inorganic materials including silicon nitride (col. 13, lines 38-49). It would have been obvious to one of ordinary skill in the art to choose any one of the inorganic materials from within the disclosed group in view of the implied functional equivalence of the materials.

It is noted that the limitation "formed by a vacuum thin film forming technique" is a process limitation in an article claim. It is the Examiner's contention that the structure taught by Ishikawa et al. is the same as the claimed structure. Thus, in the absence of evidence that the claimed method limitation results in a materially different product, this method limitation does not patentably distinguish over Ishikawa et al.

Art Unit: 1773

It has been held that even though process limitations in product claims limit and define the product by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. See *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Holly Rickman whose telephone number is (571) 272-1514. The examiner can normally be reached on Monday-Friday 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Jones can be reached on (571) 272-1535. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Holly Rickman Primary Examiner

Art Unit 1773